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Please find below and/or attached an Office communication concerning this application or proceeding.

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PTOL-90A (Rev. 04/07)

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/750,935
Filing Date: January 02, 2004
Appellant(s): SIEGEL, PHILIP S.

_____

Newgistics, Inc
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/19/2009 appealing from the Office action

mailed 11/20/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A copy of each Appeal Brief filed on April 15, 2009 relating to United States Patent Application Serial No. (09/817,353) and (10/751216) are included in Appendix C, attached in Appellants appeal brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,980,962	Arganbright	12-2005
2002/0010634	Roman	01-2002
6,246,997	Cybul	01-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and in further view of Cybul et al., US Patent No. (6246997) referred to hereinafter as Cybul.

3.   Claim 1: Arganbright teaches a method of using a computer system for on-line processing of merchandise returns *for a plurality of merchants*, comprising the steps of: *Storing a set of return rules in a database for each of the plurality of merchants (see at*

least col.62 line 51-col.63 line 10, downloading (information is stored in a database or memory) satisfaction guarantees i.e. rules of returning a merchandise); receiving, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise, (see col.63 8-11)*;* and processing the return in accordance with the set of return rules associated with the merchant (see col.63 1-10, user reviews the satisfaction guarantee rules).

Arganbright does not expressly teach using the set of return rules associated with the identified merchant and the transaction information to validate the return; upon validating the return, electronically delivering data about the customer to the merchant associated with the return. However, Roman teach using the set of return rules associated with the identified merchant and the transaction information to validate the return; upon validating the return, electronically delivering data about the customer to the merchant associated with the return (see at least Para [0021]-[0023]). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

In addition neither Arganbright nor Roman expressly teach gathering transaction history data associated with the customer from a computerized database; displaying the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history; and *receiving, from a customer, an electronic selection by a click on the particular item of merchandise, the electronic selection identifying the particular item of merchandise.*

However Cybul teaches accessing or gathering previous shopping history or transaction history data associated with a consumer from a computerized database (see at least Abstract, and col.4 lines 40-50); displaying the previous transaction or shopping history via a web browser interface where the previous shopping history is associated with the consumer (see at least col.3 line 65-col.4 lines 15); in response to displaying the transaction history associated with the consumer, receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cybul into the disclosure of Arganbright in view of Roman in order to provide the consumer with the option to return items via internet or online.

Claim 2: Arganbright teaches a method of claim 1, wherein the receiving step is performed via an Internet access tool associated with the customer, (see col.63 lines 5-8).

Claim 4: Arganbright does not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

Claim 5: official notice is taken regarding the old and notorious practice of giving notice to customer that the request has been rejected and is made final.

Claim 6: Arganbright teaches a method of claim 1, wherein the processing step is performed by determining disposition of the item, (see col.63 lines 1-10).

Claim 7: Arganbright teaches a method of claim 1, wherein the processing step is performed by determining a shipping destination of the item, (see col.63 lines 29-31).

Claim 9: official notice is taken regarding the old and notorious practice of crediting an account of the customer.

Claim 11: Arganbright teaches a method of claim 1, further comprising the step of providing a user interface to the customer, via an Internet access tool, wherein the user interface displays information associated with return of one or more items purchased by the customer, (see col.63 lines 1-11).

Claim 12: Arganbright teaches a method of claim 11, wherein the user interface displays a list of transactions associated with the customer, listing items for potential return by the customer, (see col.63 lines 1-11).

Claim 13: Arganbright teaches a method of claim 1, further comprising the step of downloading a return label to the customer via the Internet, (see col.63 lines 23-35).

Claim 14: Arganbright teaches a method of claim 1, further comprising the step of notifying a shipping agent of the return, (see col.63 lines 23-35).

Claim 25: Arganbright teaches a method of claim 24, wherein the system is further programmed to electronically provide the merchant with information about the customer, (see col.46 lines 35-53).

Claims 15, 17, 19-24, and 26-27, the limitations of claims 15, 17, 19-24, and 26-27 are similar to the limitations of claims 1 and 25, therefore claims 15, 17, 19-24, and 26-27 are rejected based on the same rationale.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

As per appellant's arguments filed on 04/15/2009, the appellant argues:

Argument A) the proposed combination of Arganbright-Roman and Cybul do not teach "transmitting a client identifier to a client system associated with the customer; in a second transaction, receiving, via the internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return

request comprising the client identifier that uniquely identifies the client system from

which the return request is received; using the identifier to identify the customer-specific

return information", **(see AB Pages 23-25)**.

In response to Argument A) the examiner respectfully disagrees.   The

examiner would to point out that the limitations in argument A, are similar to the

limitations claimed in claim 1, and are also covered by the prior art.   Arganbright

teaches a process for handling returns in compliance with the marketing company's

guarantee policy, using a website the user enters his/her invoice number (i.e. transmit a

client identifier to a client system associated with the customer) via an online form (see

at least col. 62 lines 59-65); Arganbright also teaches after the user reviews the

satisfaction guarantee policy of the company online the user selects whether to "return"

or exchange an item or plurality of items, if the user selects t return the item an on-line

form is presented to the user, the user then enters a plurality of information including but

not limited to quantity, stock number or SKU, reason for return and invoice # (i.e.

receiving, via the internet, a return request representing a request by the customer to

initiate a return of at least one item of merchandise, the return request comprising the

client identifier that uniquely identifies the client system from which the return request is

received; using the identifier to identify the customer-specific return information) , see at

least Arganbright Col. 63 lines 5-17).   Therefore Arganbright still meets the scope of the

limitation as currently claimed.

Argument B) the proposed combination of Arganbright-Roman and Cybul do not teach "receiving, from a customer, an electronic selection by a click on the particular item of merchandise, the electronic selection identifying the particular item of merchandise" **(see AB top of Page 28)**.

In response to Argument B) the examiner respectfully disagrees. Cybul teaches receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). Therefore Arganbright in view of Cybul still meets the scope of the limitation as currently claimed.

Argument C) the proposed combination of Arganbright-Roman and Cybul do not teach "using the set of return rules associated with the identified merchant and the transaction information to validate the return" **(see AB Middle of Page 30)**.

In response to Argument C) the examiner respectfully disagrees. Roman teaches wherein the transaction information associated with the item is verified against the pre-authorized acceptance policy i.e. rules of merchant, (see at least Para [0021]-[0023]). Therefore Arganbright in view of Roman still meets the scope of the limitation as currently claimed.

Argument D) the proposed combination of Arganbright-Roman and Cybul do not teach "gathering transaction history data associated with the customer from a computerized database" (**see AB Middle of Page 31**).

In response to Argument D) the examiner respectfully disagrees. Cybul teaches accessing or gathering previous shopping history or transaction history data associated with a consumer from a computerized database (see at least Abstract, and col.4 lines 40-50). Therefore Arganbright in view of Cybul still meets the scope of the limitation as currently claimed.

Argument E) the proposed combination of Arganbright-Roman and Cybul do not teach "determining disposition of the item" (**see AB Middle of Page 32**).

In response to Argument E) the examiner respectfully disagrees. Arganbright teaches determining the disposition of the item (see at least col. 63 lines 23-35). Therefore Arganbright still meets the scope of the limitation as currently claimed.

Argument F) the proposed combination of Arganbright-Roman and Cybul do not teach "notifying a shipping agent of the return" (**see AB Middle of Page 33**).

In response to Argument F) the examiner respectfully disagrees. Arganbright teaches notifying a shipping agent of the return (see at least col. 63 lines 23-35). Therefore Arganbright still meets the scope of the limitation as currently claimed.

Argument G) the proposed combination of Arganbright-Roman and Cybul do not teach "crediting an account of the customer " (**see AB Middle of Page 34**).

In response to Argument G) the examiner respectfully disagrees.   The examiner would like to first direct the attention of the Appellant and the Board of Patent & Appeals that the examiner is relying an Official Notice to teach the above mentioned limitation. As stated in the previous office actio, "The official notice statement recited in the previous office action dated 04/16/2008, *is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice*. **See, MPEP 2144.02.   Furthermore the Official Notice Traversal is no longer seasonable, therefore the Official Notice is considered to be admitted prior art.**" Therefore proposed combination of Arganbright-Roman-Cybul and Official Notice, still meets the scope of the limitation as currently claimed.

Argument H) the Appellant argues that there is no motivation to combine references (**see AB Middle of Page 35**).

In response to argument H) examiner respectfully disagrees.   The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness.

Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Roman and Cybul into the disclosure of Arganbright and the results would have been predictable to one of ordinary skill in the art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MUSSA SHAAWAT/
Examiner, Art Unit
July 16, 2009

Conferees:

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Vincent Millin /vm/

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